

REMARKS

Claims 1-84 were originally presented in the subject application. Claims 3, 11, 16, 31, 39, 44, 59, 67 and 72 were amended, and claims 85-112 added in an Amendment and Response to Office Action dated November 17, 2004. Claims 1, 29, 57 and 85 were amended in an Amendment and Response to Office Action dated April 28, 2005. Claims 1, 29, 57 and 85 were amended in an Amendment and Response to Office Action dated November 28, 2005.

Claims 1, 27, 29, 55, 57, 83, 85 and 111 have hereinabove been amended as noted below to more particularly point out and distinctly claim the subject invention. No claims have herein been added. Claims 2-3, 30-31, 58-59 and 86-87 have herein been canceled without prejudice. However, Applicants reserve the right to file a continuation on the canceled claims. Therefore, claims 1, 4-29, 32-57, 60-85 and 88-112 remain in this case.

The amendment to claim 1 includes the substance of claims 2 and 3; the amendment to claim 29 includes the substance of claims 30 and 31; the amendment to claim 57 includes the substance of claims 58 and 59; and the amendment to claim 85 includes the substance of claims 86 and 87. The amendments to claims 27, 55, 83 and 111 merely correct dependencies resulting from the above noted amendments.

Applicants respectfully request reconsideration and withdrawal of the grounds of rejection.

35 U.S.C. §102 Rejection

The Office Action rejected claims 1, 2, 27, 29, 30, 55, 57, 58, 83, 85, 86 and 111 under 35 U.S.C. §102(b), as allegedly anticipated by ERPNet, Dialog File 20, accession No. 02821200.

Expressly without acquiescing to the rejection, and reserving the right to file a continuation therefor, Applicants have herein amended the independent claims to include the substance of the two claims immediately following each, which includes claims not included in this rejection. Therefore, Applicants submit the rejection is now moot.

35 U.S.C. §103 Rejection

The Office Action rejected claims 3-26, 28, 31-54, 56, 59-82, 84, 87-110 and 112 under 35 U.S.C. §103(a), as allegedly obvious over ERPNet. Applicants respectfully, but most strenuously, traverse this rejection.

Applicants have amended each of independent claims 1, 29, 57 and 85 to include the substance of the two claims immediately following the same. Thus, claim 1 is now effectively claim 3, claim 29 is now effectively claim 31, claim 57 is now effectively claim 59, and claim 85 is now effectively claim 87.

Against claims 3, 31, 59 and 87, the Office Action presents no proof of obviousness, alleging simply:

...ERPNet discloses using middleware to communicate messages (MQSeries or MSMQ). ERPNet does not specify that the middleware produces the reply that updates the display on where a package is currently located. It would have been obvious for one of ordinary skill in the art to use the already existing middleware to produce this necessary reply since it is already installed and would not necessitate further software purchases or installation.

However, the Office Action appears to ignore the clear language of the Board's decision with regard to these claims:

We will not sustain the rejection of claims 3 and 4. We agree with Appellants to the extent that the rejection fails to show description, sufficient for anticipation, in ERPNet for the subject matter of claim 3. The reference simply fails to describe the claimed interaction between the ERP application and the messaging middleware. Although ERPNet uses the same messaging middleware as taught by Appellants, the claimed interaction does not necessarily follow in the reference because the "reply" in ERPNet is not an application-level reply as described in Appellants' Specification. Moreover, ERPNet discloses that it is "Candle's Roma Systems Manager" (¶ 9, and further described in the reference) by which users may see a graphical depiction of order progress, without details of the particular components that are required in providing information for the depiction. Claim 4 adds further limitations to claim 3, which are also not met by the reference.

While the Board's decision was technically addressing an anticipation rejection, the application to the present rejection is patently clear.

Moreover, the MPEP Section 1214.04 is quite clear on the procedure to follow after a reversal by the Board:

If the examiner has specific knowledge of the existence of a particular reference or references which indicate nonpatentability of any of the appealed claims as to which the examiner was reversed, he or she should submit the matter to the Technology Center (TC) Director for authorization to reopen prosecution under 37 CFR 1.198 for the purpose of entering the new rejection. See MPEP § 1002.02(e) and MPEP § 1214.07. The TC Director's approval is placed on the action reopening prosecution.

Applicants submit no such specific knowledge has been conveyed, nor any proof at all beyond an unsupported allegation. This is particularly troubling in light of the clear language of the Board's decision regarding claim 3 and ERPNet.

Still further, the Examiner has not changed during substantive prosecution, which has been for years (the case was filed in 2000). Yet, only now, after a Board reversal on claim 3 (and similar scope claims in other sets) is there an (unsupported) obviousness rejection over ERPNet, which has also been part of the case for years. As required under MPEP Section 2163, Part III, a complete patentability determination under all statutory requirements, including Section 103, was supposed to have been made literally years ago. Worse, there have been countless opportunities to raise the issue during many papers, even ignoring the requirement of initial determination under all statutory requirements.

As a side issue, Applicants sincerely believe they have been put to unnecessary and unfair time and expense with this Office Action in light of the appeal, and request that the case as amended be sent on to allowance.

Therefore, for at least the reasons noted above, Applicants submit that amended claim 1 cannot be obviated over ERPNet.

The other independent claims lend themselves to similar remarks and, likewise, also cannot be made obvious.

CONCLUSION

Applicants submit that the dependent claims not specifically addressed herein are allowable for the same reasons as the independent claims from which they directly or ultimately depend, as well as for their additional limitations. In addition, Applicants do not acquiesce to any "well-known in the art" or similar allegations made in the Office Action. Further, unless specifically set forth otherwise, Applicants request proof of any such allegations in the form of properly cited prior art or other allowed evidence.

For all the above reasons, Applicants maintain that the claims of the subject application define patentable subject matter and earnestly request allowance of claims 1, 4-29, 32-57, 60-85 and 88-112.

If a telephone conference would be of assistance in advancing prosecution of the subject application, Applicants' undersigned attorney invites the Examiner to telephone him at the number provided.

Respectfully submitted,

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Dated: June 26, 2008.

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